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Remarks:

Regarding the objection to the specification; indication of priority document:

The amendment to the specification entered above is believed to fully address and overcome the Examiner's objection. The filing date, and the relevant priority date of PCT/GB03/04419 are of public record.

Regarding newly presented claims:

The subject matter of the newly presented claims in this paper find full support in the applicant's specification as filed. Namely support is found in one or more of the Examples presented by the applicant in their specification.

Regarding the objection to claim 24:

The amendment to claim 24 presented in this paper is believed to fully address and overcome the Examiner's grounds of rejection.

Regarding the rejection of claims 1-2, 4-5, 10-15 and 25 under 35 USC 103(a) in view of US 5540864 to Michael (hereinafter simply "Michael"):

The applicant respectfully traverses the Examiner's rejection of the indicated claims over the Michael reference.

Prior to discussing the merits of the Examiner's position, the undersigned reminds the Examiner that the determination of obviousness under § 103(a) requires consideration of the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1 [148 USPQ 459] (1966): (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, of nonobviousness. *McNeil-PPC, Inc. v. L. Perrigo Co.*, 337 F.3d 1362, 1368, 67 USPQ2d 1649, 1653 (Fed. Cir. 2003). There must be some suggestion, teaching, or motivation arising from what the prior art would have taught a person of ordinary skill in the field of the invention to make the proposed changes to the reference.

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In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). But see also *KSR International Co. v. Teleflex Inc.*, 82 USPQ2D 1385 (U.S. 2007).

A methodology for the analysis of obviousness was set out in *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000) A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."

It must also be shown that one having ordinary skill in the art would reasonably have expected any proposed changes to a prior art reference would have been successful. *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207, 18 USPQ2d 1016, 1022 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988); *In re Clinton*, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

Returning now to the Michael reference, it is clear to even the skilled artisan reading that reference that the Michael compositions are essentially distinguishable over those of the presently claimed invention in several important respects. First, it is quite clear that Micheal's compositions require a specific 'system' of essential constituents in or to provide his hard surface cleaning composition. Namely Michael notes at columns 1-2 that:

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SUMMARY OF THE INVENTION

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The present invention relates to an aqueous, liquid, hard surface detergent composition comprising: (a) zwitterionic detergent surfactant, containing a cationic group, preferably a quaternary ammonium group, and an anionic group, preferably a carboxylate, sulfonate, or sulfate group, more preferably a sulfonate group; (b) solvent/buffer system that

comprises either monoethanolamine, beta-aminoalkanol which contains from about three to about six carbon atoms, or mixtures thereof, preferably monoethanolamine; (c) optional detergent builder; and the balance being (d) aqueous solvent system and, optionally, minor ingredients. The composition preferably does not contain amounts of materials, like conventional detergent builders, etc., that deposit on the surface being cleaned and cause unacceptable spotting/filming. The compositions can be formulated at usage concentrations, or as concentrates, and can be packaged in a container having means for creating a spray to make application to hard surfaces more convenient.

With respect to useful surfactants, it is made abundantly clear that a zwitterionic surfactant must be present, as is noted by Michael at col. 2 wherein he recites:

comprises either monoethanolamine, beta-aminoalkanol which contains from about three to about six carbon atoms, or mixtures thereof, preferably monoethanolamine; (c) optional detergent builder; and the balance being (d) aqueous solvent system and, optionally, minor ingredients. The composition preferably does not contain amounts of materials, like conventional detergent builders, etc., that deposit on the surface being cleaned and cause unacceptable spotting/filming. The compositions can be formulated at usage concentrations, or as concentrates, and can be packaged in a container having means for creating a spray to make application to hard surfaces more convenient.

With respect to further surfactants Michael makes clear that such are optionally present as "co-surfactants"; see Michael at col. 3, line 56 – col. 4, line 56. Michael further makes clear that his composition necessarily also comprises a solvent/buffer system

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which necessarily comprises monoethanolamine, beta-alkanolamine having 3 – 6 carbon atoms or mixtures thereof.

As is evident from a review of the applicant's claimed invention, Michael does not claim or indicate any of the following requirements: (i) germicidal activity in general, and specifically Michael does not disclose or suggest any germicidal benefit or yet more specifically, the use of o-benzyl-p-chlorophenol; (ii) the utility of combinations of both an anionic soap surfactant coupled with a terpene constituent (pine oil fractions); or (iii) the substantive loss of light transmittance when diluted into water. None of Michael's example compositions indeed demonstrate the presence of *any* anionic soap surfactant, or of any constituent which would be expected to provide a germicidal benefit. Further, Michael makes quite clear from his examples that his composition is intended to be a "ready to use" composition and is not intended to be further diluted with water before being used, as is noted at col. 11:

These compositions have exceptionally good cleaning properties. They can also be formulated to have good "shine" properties, i.e., when used to clean glossy surfaces, without rinsing.

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The compositions can be formulated to be used at full strength, where the product is sprayed onto the surface to be cleaned and then wiped off with a suitable material like cloth, a paper towel, etc. They can be packaged in a package that comprises a means for creating a spray, e.g., a pump, 50 aerosol propel pellant and spray valve, etc.

In light of the amended claims, and in further view of the foregoing remarks, the Examiner's reliance upon Michael appears to be improper. Reconsideration and withdrawal of the current rejection of the claims is solicited.

Regarding the rejection of claim 3 in view of US 5540864 to Michael (hereinafter simply "Michael"), further in view of US 5335373 to Dangman (hereinafter simply

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"Dangman"), further in view of US 5977183 to Scepanski (hereinafter simply *"Scepanski")*:

The applicant respectfully traverses the Examiner's rejection of the indicated claims over the combined Michael, Dangman and Scepanski references.

For the sake of brevity the applicant herein repeats and incorporates by reference the prior remarks entered *supra* concerning Michael as being similarly relevant to the current rejection of claim 3.

Although claim 3 has been canceled in this paper, the applicant nonetheless addresses the rejection as being relevant to claim 1.

Although the Examiner introduces the Dangman and Scepanski references in order to address the admitted shortcoming that Michael fails to teach o-benzyl-p-chlorophenol, of for that matter, any other germicidal constituent, the Examiner's reliance upon Dangman and Scepanski to provide o-benzyl-p-chlorophenol does not however overcome the inherent shortcomings of the Michael reference discussed *supra*. First, there is no motivation espoused by Michael to modify his composition to have any antimicrobial benefit or to include any antimicrobial constituent. Michael is solely to a ready-to-use cleaner for providing a shiny finish to hard surfaces (... to clean glossy surfaces, without rinsing,...). Second, it is believed that a skilled artisan concerned with producing a dilutable, blooming-type composition such as are provided according to preferred aspects of applicant's invention would not, at the threshold, consider Dangman's disclosure to be relevant:

United States Patent [19]

Dangman et al.

**[54] PROTECTIVE MEDICAL GLOVES AND
METHODS FOR THEIR USE**

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It is the applicant's contention that chemical formulator would not look to the medical glove "art" in considering the types of dilutable, germicidal compositions which preferred embodiments of applicant's inventive compositions provide.

The Examiner is respectfully reminded that a methodology for the analysis of obviousness was set out in *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000) A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."

It must also be shown that one having ordinary skill in the art would reasonably have expected any proposed changes to a prior art reference would have been successful. *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207, 18 USPQ2d 1016, 1022 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988); *In re Clinton*, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

It is the applicant's firm view that *Dangman* is improperly applied, but even if considered, would not suggest nor provide any basis for rendering the applicant's claimed invention as being obvious. Similarly, the applicant believes that the rejection based on the combined Michael and Scepanski reference is also improper and should be withdrawn. Scepanski provides substantially solid antimicrobial compositions, as noted in col. 1:

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DETAILED DESCRIPTION OF THE
INVENTION

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The invention consists of antimicrobial compositions manufactured into a substantially solid and nonflowable form. It is preferred that the solid be produced in a container, e.g., a bottle or jar, such that the container can be used with a solid dispenser. In a typical solid dispenser, the container

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While Scepanski later notes that these are used to form liquid disinfectant compositions therefrom, nowhere in Scepanski is there disclosed the formation of a liquid concentrate composition which, when dissolved would provide both a blooming benefit and concurrently a germicidally effective composition. Scepanski's solid compositions are necessarily formed as solids, or pasty solids and then diluted in water. Significantly each of his Examples 1, 2, 2A, 2B, 3A, 3B, 5, and 6 were solid compositions formed from quaternary ammonium compound which would be unuseable in the presence of an anionic soap based surfactant. Scepanski's Example 4 although based on orthobenzylparachlorophenol was simply melted and solidified, and no later example indicates its use with any other constituent and thus it is assumed to be only suitable to be diluted with water. Scepanski's Example 3 utilized n-coco-1,3-diaminopropane concurrently with a flaked cocomonooethanolamide as a surfactant, while his Example 7 utilized an unspecified liquid antimicrobial composition "FMB1210-50" with no further added constituent. None of Scepanski's compositions were provided as liquid, dilutable concentrate compositions nor was there any indication of any loss of light transmittance.

The Examiner is respectfully reminded that the "predictability or lack thereof in the art refers to the ability of one skilled in the art to extrapolate the disclosed or known results to the claimed invention. If one skilled in the art can readily anticipate the effect of a change within the subject matter to which the claimed invention pertains, then there is predictability in the art. On the other hand, if one skilled in the art cannot readily anticipate the effect of a change within the subject matter to which that claimed invention pertains, then there is lack of predictability in the art. Accordingly, what is known in the

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art provides evidence as to the question of predictability. In particular, the court in *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 368-70 (CCPA 1971), stated:

"[i]n the field of chemistry generally, there may be times when the well-known unpredictability of chemical reactions will alone be enough to create a reasonable doubt as to the accuracy of a particular broad statement put forward as enabling support for a claim. This will especially be the case where the statement is, on its face, contrary to generally accepted scientific principles. Most often, additional factors, such as the teachings in pertinent references, will be available to substantiate any doubts that the asserted scope of objective enablement is in fact commensurate with the scope of protection sought and to support any demands based thereon for proof."

The present invention cited in the current claims is unobvious over the Scepanski reference if considered singly for the reasons stated above, as well as if considered in conjunction with Michael. Although the Examiner's reliance upon Scepanski is to introduce o-benzyl-p-chlorophenol to Michael, for the reasons stated above with reference to Dangman, there is no motivation for such a combination and even if considered, the consideration of Scepanski would not address or overcome the fatal shortcomings of the Michael reference or change its essential nature. Scepanski's solid compositions are even more remote, and no artisan considering both references would have reached the currently claimed invention which is now claimed without the exercise of inventive facility.

Accordingly, reconsideration of the propriety of the rejection of claim 3, as well as claim 1 as presented in this paper, in view of the combined Michael, Dangman and Scepanski references, and withdrawal of the rejection is solicited.

Regarding the rejection of claims 16-21 in view of US 5540864 to Michael (hereinafter simply "Michael"), further in view of US 4666940 to Bischof et al (hereinafter simply "Bischof"):

The applicant respectfully traverses the Examiner's rejection of the indicated claims over the combined Michael and Bischof references.

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For the sake of brevity the applicant herein repeats and incorporates by reference the prior remarks entered *supra* concerning Michael as being similarly relevant to the current rejection of claims 16-21.

The applicant's amendments entered to claim 1 coupled with the rebuttal of the prior art references of Michael, Dangman and Scepanski are believed to render claim 1 allowable. Current claims 16-21 are believed to be presumptively allowable over the prior art Michael and Bischof references as well, as being dependent from claim 1. Bischof's acaricidal compositions which necessarily include benzyl benzoate as an essential constituent in each and every composition, is believed to be of little relevance to the currently claimed invention.

Accordingly reconsideration of and withdrawal of the outstanding grounds of rejection is solicited.

As the present claims based on a specific halophenol (o-benzyl-p-chlorophenol) are believed to be allowable over the prior art of record, the undersigned respectfully requests the *rejoinder* of at least the general class of "halophenols" into the present application, (presently withdrawn claim 3) namely:

"the a) non-cationic antimicrobial agent is a mono- and poly-alkyl and aromatic halophenol selected from the group p-chlorophenol, methyl p-chlorophenol, ethyl p-chlorophenol, n-propyl p-chlorophenol, n-butyl p-chlorophenol, n-amyl p-chlorophenol, sec-amyl p-chlorophenol, n-hexyl p-chlorophenol, cyclohexyl p-chlorophenol, n-heptyl p-chlorophenol, n-octyl p-chlorophenol, o-chlorophenol, methyl o-chlorophenol, ethyl o-chlorophenol, n-propyl o-chlorophenol, n-butyl o-chlorophenol, n-amyl o-chlorophenol, tert-amyl o-chlorophenol, n-hexyl o-chlorophenol, n-heptyl o-chlorophenol, o-benzyl p-chlorophenol, o-benzyl-m-methyl p-chlorophenol, o-benzyl-m, m-dimethyl p-chlorophenol, o-phenylethyl p-chlorophenol, o-phenylethyl-m-methyl p-chlorophenol, 3-methyl p-chlorophenol,

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3,5-dimethyl p-chlorophenol, 6-ethyl-3-methyl p-chlorophenol, 6-n-propyl-3-methyl p-chlorophenol, 6-iso-propyl-3-methyl p-chlorophenol, 2-ethyl-3,5-dimethyl p-chlorophenol, 6-sec-butyl-3-methyl p-chlorophenol, 2-iso-propyl-3,5-dimethyl p-chlorophenol, 6-diethylmethyl-3-methyl p-chlorophenol, 6-iso-propyl-2-ethyl-3-methyl p-chlorophenol, 2-sec-amyl-3,5-dimethyl p-chlorophenol 2-diethylmethyl-3,5-dimethyl p-chlorophenol, 6-sec-octyl-3-methyl p-chlorophenol, p-chloro-m-cresol, p-bromophenol, methyl p-bromophenol, ethyl p-bromophenol, n-propyl p-bromophenol, n-butyl p-bromophenol, n-amyl p-bromophenol, sec-amyl p-bromophenol, n-hexyl p-bromophenol, cyclohexyl p-bromophenol, o-bromophenol, tert-amyl o-bromophenol, n-hexyl o-bromophenol, n-propyl-m,m-dimethyl o-bromophenol, 2-phenyl phenol, 4-chloro-2-methyl phenol, 4-chloro-3-methyl phenol, 4-chloro-3,5-dimethyl phenol, 2,4-dichloro-3,5-dimethylphenol, 3,4,5,6-terabromo-2-methylphenol, 5-methyl-2-pentylphenol, 4-isopropylmethylphenol, para-chloro-meta-xyleneol, dichloro meta xyleneol, chlorothymol, and 5-chloro-2-hydroxydiphenylmethane. "

None of the prior art documents cited by the Examiner appear to be sufficiently relevant to the foregoing class of mono- and poly-alkyl and aromatic halophenol which justifies the Examiner's prior *Restriction Requirement/Election of Species* which the applicant had responded to only with traverse. It is believed that reinstatement of the subject matter of claim 3 is proper.

PETITION FOR A ONE-MONTH EXTENSION OF TIME

The applicants respectfully petition for a one-month extension of time in order to permit for the timely entry of this paper. The Commissioner is hereby authorized to charge the fee to Deposit Account No. 14-1263 with respect to this petition.

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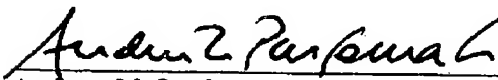
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CONDITIONAL AUTHORIZATION FOR FEES

Should any further fee be required by the Commissioner in order to permit the timely entry of this paper, the Commissioner is authorized to charge any such fee to Deposit Account No. 14-1263.

Should the Examiner in charge of this application believe that telephonic communication with the undersigned representative would meaningfully advance the prosecution of this application towards allowance, the Examiner is invited to contact the undersigned at their earliest convenience.

Respectfully Submitted;



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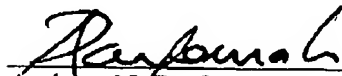
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Andrew N. Parfomak

01 Feb 2009

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